

ALBRECHT DORSCHNER ET AL.  
USSN 09/678,766

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

New claims 26-29 are supported by the examples, and the fifth paragraph on page 21 of the specification. Applicants do not believe the new claims introduce new matter.

The sole issue for consideration is the rejection of claims 4-23 under 35 USC § 102(b) as being anticipated by Ascione et al. ("Ascione"), U.S. Patent No. 5,858,334. In response, Applicants would remind the Examiner that anticipation requires that each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference, and, further, the absence in the prior art reference of even a single one of the claim elements is sufficient to negate anticipation. *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Ascione has no teaching of instant emulsifier A, the lipophilicity of which is dependent upon pH. Consequently, Ascione cannot anticipate the present claims.

The Examiner says Ascione in example 1 teaches cetylstearyl alcohol containing ethylene oxide. However, the Examiner has not shown such a mixture inherently to produce a fatty alcohol ethoxylate. In the absence of such a showing, the Examiner has not made out a *prima facie* case of anticipation. *See, again, Robertson, id.*, for the proposition that if the Examiner relies on a theory of inherency as to any particular element, then the extrinsic evidence must make clear that such element is *necessarily* present in the thing described in the reference, and

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the presence of such element therein would be so recognized by persons skilled in the art. The Examiner has not satisfied this burden.

Even if inherency is proven, such teachings would not appear to extend to the subject matter of new claims 26-29.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

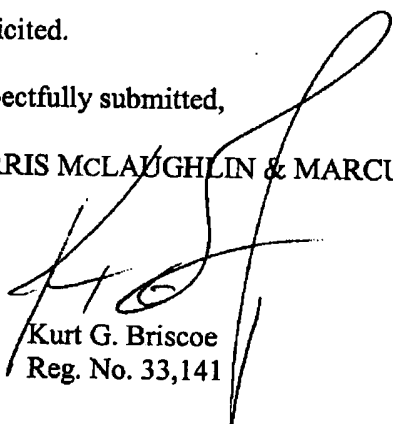
Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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By

  
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.116 and the accompanying Request for Continued Examination and Petition for Extension of Time (8 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: May 21, 2003

By

  
Kurt G. Briscoe